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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/590,592	06/08/2000	David S. Jones	252312007300	1002
25226	7590	06/16/2004		
MORRISON & FOERSTER LLP 755 PAGE MILL RD PALO ALTO, CA 94304-1018			EXAMINER LUKTON, DAVID	
			ART UNIT	PAPER NUMBER

1653

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/590,592

Applicant(s)

JONES ET AL.

Examiner

David Lukton

Art Unit

1653

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 November 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 38, 46, 54-57, 66-71, 82-87, 119, 124, 126-128, 136-140 and 147-162 is/are allowed.
- 6) ☒ Claim(s) 89-93, 108-110, 131-135 and 141-146 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Continuation of Disposition of Claims: Claims pending in the application are 38,46,54-57,66-71,82-87,89-93,108-110,119,124,126-128 and 131-162.

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/21/03 has been entered.

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Claims 16-39, 44-47, 54-130 were stated to be allowable in the Notice of allowability mailed 8/21/03. Subsequently, an RCE was filed on 11/21/03, accompanied by an amendment. Pursuant to that amendment, claims 16-37, 39-45, 47-53, 58-65, 72-81, 88, 94-107, 111-118, 120-123, 125, 129-130 have been cancelled, and claims 131-162 added. Claims 38, 46, 54-57, 66-71, 82-87, 89-93, 108-110, 119, 124, 126-128, 131-162 are pending.

The following abbreviations are used hereinbelow:

“**BAM**” represents a biologically active molecule

“**VPM**” represents a valency platform molecule



Claims 89-93, 108-110, 131-135, 141-146 are rejected under 35 U.S.C. §112 second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

- Claim 89 recites that a conjugate according to claim 46 can be prepared by covalently bonding BAM's to a VPM. If the VPM is that of claim 38, it is not difficult to see how the conjugate is to be prepared. But if the VPM is entirely different from that of claim 38, it is not at all clear as to how one would endeavor to prepare the conjugate. The same issue applies in the case of claim 131.
- The first line of text of claim 108 recites that the VPM is "of claim 38". However, upon reading the remainder of the claim, it is evident that the claimed compound is not in fact "of claim 38", but rather, is the VPM of claim 38 to which further contains bivalent linker molecules. The claim dependence would be improper on this basis alone. In addition, claim 108 permits the aminooxy groups to be protected, an option not permitted by claim 38. Accordingly, the dependence of claim 108 upon claim 38 is not proper. The same issue applies in the case of claim 141 versus claim 66, and in the case of claim 144 versus claim 82.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Lukton whose telephone number is 571-272-0952. The examiner can normally be reached Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher Low, can be reached at 571-272-0951. The fax number for the organization where this application or proceeding is assigned is 703-872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 571-272-1600.

David Lukton

DAVID LUKTON
PATENT EXAMINER
GROUP 1800